



## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Kazuhisa MUKAI et al

Art Unit: 1651

Application No.: 10/523,920

Examiner: L.E. Barnhart

I. A. Filing Date: July 7, 2003

Washington, D.C.

Filed: February 7, 2005

Atty.'s Docket: MUKAI=2

For: PROCESS FOR PRODUCING...

Confirmation No.: 1923

Customer Service Window, **Mail Stop Amendment**

Date: April 24, 2007

Honorable Commissioner for Patents  
U.S. Patent and Trademark Office  
Randolph Building, 401 Dulany Street  
Alexandria, Virginia 22314

Sir:

Transmitted herewith is a REPLY TO REQUIREMENT FOR ELECTION OF SPECIES in the above-identified application.☐ Small Entity Status: Applicant(s) claim small entity status. See 37 C.F.R. §1.27.☒ No additional fee is required.☐ The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS
TOTAL	*	MINUS	** 20	0
INDEP.	*	MINUS	*** 3	0
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				

ADDITIONAL FEE TOTAL

SMALL ENTITY		
RATE		ADDITIONAL FEE
x 25		\$
x 100		\$
+ 180		\$
ADDITIONAL FEE TOTAL		\$

OTHER THAN SMALL ENTITY		
RATE		ADDITIONAL FEE
x 50		\$
x 200		\$
+ 360		\$
TOTAL		\$

\* If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.

\*\* If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.

\*\*\* If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

☒ Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

☐ It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

## Small Entity

## Response Filed Within

☐ First - \$ 60.00  
☐ Second - \$ 225.00  
☐ Third - \$ 510.00  
☐ Fourth - \$ 795.00

Month After Time Period Set

## Other Than Small Entity

## Response Filed Within

☐ First - \$ 120.00  
☐ Second - \$ 450.00  
☐ Third - \$ 1020.00  
☐ Fourth - \$ 1590.00

Month After Time Period Set

☐ Less fees (\$ ) already paid for month(s) extension of time on .☐ Please charge my Deposit Account No. 02-4035 in the amount of \$ .☐ Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$ .☐ A check in the amount of \$ is attached (check no. ).

☒ The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK, P.L.L.C.

Attorneys for Applicant(s)

Facsimile: (202) 737-3528  
Telephone: (202) 628-5197

By:   
Sheridan Neimark  
Registration No. 20,520



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

ATTY.'S DOCKET: MUKAI=2

In re Application of:	)	Confirmation No.: 1923
	)	
Kazuhisa MUKAI et al	)	Art Unit: 1651
	)	
I.A. Filing Date: 07/07/2003	)	Examiner: L. E. Barnhart
371(c) Date: February 7, 2005	)	
	)	April 24, 2007
U.S. Appln. No.: 10/523,920	)	
	)	
For: PROCESS FOR PRODUCING...	)	
	)	

REPLY TO REQUIREMENT FOR ELECTION OF SPECIES

Customer Service Window, Mail Stop Amendment  
Honorable Commissioner for Patents  
U.S. Patent and Trademark Office  
Randolph Building  
401 Dulany Street  
Alexandria, Virginia 22314

Sir:

Applicants are in receipt of the Office Action mailed March 27, 2007, substantially entirely in the nature of a requirement for election of species. Applicants reply below.

First, however, applicants note that box 12 of the Office Action Summary has been checked, but none of the boxes therebeneath. The present application is of course the U.S. National Phase of PCT/JP08/08600, and a copy of the priority document will have been forwarded to the PTO by the International Bureau of WIPO. The PCT branch of the PTO appears to have acknowledged receipt of same in the notice mailed June 20, 2006. Accordingly, applicants respectfully request the examiner to fully acknowledge receipt of applicants papers filed under \$119.

The PTO has required an election of one species from among the nine listed. As applicants must make an election even though the requirement is traversed, applicants hereby respectfully and provisionally elect "liquefied starch" with traverse and without prejudice. All twenty (20) claims read on this elected embodiment.

The requirement is traversed on the basis that there is no demonstrated lack of unity of invention. All the claims are generic, and thus all the claims share the same or corresponding special technical features.

With respect, applicants believe and submit that the election of species requirement is quite unreasonable. Nine species (a) to (i) indicated by the examiner are all substrates in the glucosyl-transferring reaction conducted by the  $\alpha$ -isomaltosyl glucosaccharide-forming enzyme used in the process of claim 1. Please see paragraphs 0024 and 0026 of the published present application.

Furthermore, the nine species (a) to (i) are the saccharides that are known as " $\alpha$ -1,4 glucan". " $\alpha$ -1,4 glucan" is a saccharide that consists of glucose moieties bound via the  $\alpha$ -1,4 linkage. Therefore the nine species (a) to (i) absolutely are related saccharides. While the term  $\alpha$ -1,4 glucan is not literally recited in the specification, the specification describes nine kinds of saccharides as "a saccharide with glucose polymerization degree of 2 or higher and bearing the  $\alpha$ -1,4 glucosidic linkage as a linkage at the non-reducing end" (see the last sentence in paragraph 0026). It is therefore unbelievable that the nine species would be properly

Appln. No. 10/523,920  
Amd. dated April 24, 2007  
Reply to Office Action of March 27, 2007

considered as not so linked as to form a single inventive concept under PCT Rule 13.1.

Withdrawal of the requirement is in order and is respectfully requested.

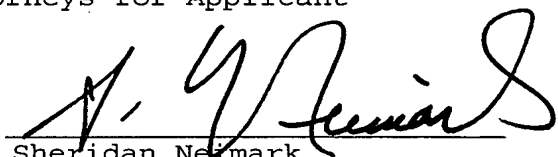
Applicants further note for the record that as all twenty (20) claims read on the elected subject matter, all twenty claims must in any event be examined. Therefore, even if the more stringent standard restriction practice were in order, which it is not, the second paragraph of MPEP 803 would come into play. As all twenty claims must be examined, it surely would not constitute a "serious burden" to withdraw the requirement and provide a full examination on the merits.

Applicants now respectfully await the results of a first examination on the merits.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.  
Attorneys for Applicant

By

  
Sheridan Neimark  
Registration No. 20,520

SN:kg  
Telephone No.: (202) 628-5197  
Facsimile No.: (202) 737-3528  
G:\BN\S\SUMA\MUKAI2\pto\2007-04-24 PCTRPLY ELECT.doc